

In re: Appln No. 09/745,304  
Amendment dated January 15, 2004  
Reply to Office action of July 15, 2003

Atty Docket: 6006-019

**Remarks**

Claims 1-7, 10-11 and 14-26 were pending prior to the present amendment. Upon entry of the present amendment, new Claims 27-51 are pending, wherein Claims 27 and 38 are independent claims. Because the number of independent claims and the number of total claims are equal to the largest number of pending independent and total claims in the application to date, it is believed that no additional claim fees are required.

The new claims are based in part upon the canceled claims with additional limitations directed to formation of a substantially homogeneous metal constitution (supported at page 9, lines 18-22), forming a pattern after formation of the device-forming metal, (as opposed to forming a pattern on the metal, then removing excess material; supported at page 14, lines 4-6); and particular deposition conditions that allows for control of the heterogeneities (supported at page 11, lines 5-6; page 13, lines 9-10, 11-12, and 19-21; page 15, line 10).

**I. Evidence that the January 30, 2002 Information Disclosure Statement was timely filed is attached.**

Applicant hand-filed an Information Disclosure Statement (IDS) on January 30, 2002, which has, to-date, not been considered by the Examiner. During a telephone conference with the Examiner on January 8, 2003, the Examiner searched the Office records and learned that the entire IDS was, received by the Office, but was separated by the Office into two boxes, due to its volume. As the IDS was timely filed pursuant to 37 C.F.R. 1.97, and has been confirmed by the Examiner to be complete, Applicant submits that it is incumbent on the Examiner to consider all of the cited references filed in the IDS of January 30, 2002 in the course of further examination of this application.

Nevertheless, in the July 15, 2003 Office Action, the Examiner alleged that no record of an IDS for the present invention exists, and that the IDS either was not received, or not placed in the application file. The Examiner encouraged the applicant to resubmit the IDS with the certified postcard. A duplicate IDS is attached to this paper along with a hand delivery cover page and a postcard (both stamped as received by Technology Center 3700 on January 30, 2002).

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Applicants hope that this is sufficient to satisfy the Examiner as to the delivery of the IDS and 167 references cited therein. However, Applicants have not enclosed the 167 references cited in the IDS. It would work an undue hardship for Applicants to be required to reconstitute the filing in full, and to remail the references (which constitute two boxes of materials). Applicants would be very grateful if the Examiner could conduct a search for the references in the technology center, before asking the Applicants to undergo the arduous task of finding and mailing the references a second time.

**II. The rejection of Claims 1-7, 10-11 and 14-26 under 35 U.S.C. 102 over Clubb, et al. (U.S. Patent No. 6,203,732; "Clubb") is moot in view of the amendments presented herein and should be withdrawn.**

The rejection under 35 U.S.C. §102 in view of Clubb is moot in light of the amendments to the claims. However, with the prospect that the Examiner may apply Clubb to the pending claims, Applicants will address the application of Clubb. Anticipation under 35 U.S.C. §102 requires that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). *In re Robertson*, 49 USPQ2d 1949 (Fed. Cir. 1999). It would be improper to apply Clubb to the pending claims because the reference fails to disclose each element of the claims.

Clubb does not anticipate any of the pending claims, because it does not teach

vacuum depositing a device-forming metal onto an unpatterned, exterior surface of a generally cylindrical substrate at a deposition rate that controls a formation of heterogeneities to form a generally tubular, unpatterned, substantially homogeneous metal film on the exterior surface of the substrate (Claim 27)

or

vacuum depositing a biocompatible material onto the shaped exterior surface of the substrate at a deposition rate, with a substrate temperature, and at a deposition chamber pressure that controls a formation of heterogeneities on a surface of a biocompatible material layer (Claim 38).

The Examiner erroneously alleged that Clubb discloses controlling the formation of heterogeneities (citing Col. 5, lines 12-20). The cited passage refers to nothing about heterogeneities or homogeneous surfaces. It merely provides for multiple masking and etching

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to vary the depressed pattern, and use of multiple layers of materials, including a radiopaque layer. For at least this reason alone, Clubb cannot anticipate the pending claims.

Moreover, Clubb teaches the formation of a pattern on a substrate, depositing the device-forming material on the substrate in conformance to the pattern, then disposing of excess material to form a device according to the pattern formed during the deposition. By contrast, Claim 27-37 provides an unpatterned, cylindrical substrate having a metal exterior surface. Accordingly, when the device-forming metal is deposited on the substrate, there is no pattern. In Claims 27-37 the device pattern is formed by machining the deposited metal, rather than by removal of material until the preformed pattern is revealed. In other words, Clubb forms the stent pattern during the deposition process, while Claims 27-37 forms a blank during the deposition process, then separately machines in the device pattern. This is a further reason Clubb cannot anticipate Claims 27-37. For the foregoing reasons, Applicants respectfully request withdrawal of the application of Clubb as an anticipating reference.

**III. The rejection of 11 and 14-26 under 35 U.S.C. 102 over Roth (U.S. Patent No. 6,069,175; "Roth") is moot in light of the present amendment and should be withdrawn.**

The rejection under 35 U.S.C. §102 in view of Roth is moot in light of the amendments to the claims. However, with the prospect that the Examiner may apply Roth to the pending claims, Applicants will address the application of Roth. As discussed above, anticipation requires that the cited reference teach each and every element of the rejected claims. Here Roth cannot anticipate the pending claims because it fails to disclose each element of the claims.

Roth does not anticipate any of the pending claims, because it does not teach

vacuum depositing a device-forming metal onto an unpatterned, exterior surface of a generally cylindrical substrate at a deposition rate that controls a formation of heterogeneities to form a generally tubular, unpatterned, substantially homogeneous metal film on the exterior surface of the substrate (Claim 27)

or

vacuum depositing a biocompatible material onto the shaped exterior surface of the substrate at a deposition rate, with a substrate temperature, and at a deposition

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chamber pressure that controls a formation of heterogeneities on a surface of a biocompatible material layer (Claim 38).

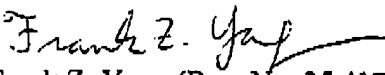
As for Clubb, the Examiner erroneously alleged that Roth discloses controlling the formation of heterogeneities (citing Col. 65, lines 10-15). The cited passage refers to nothing about heterogeneities or homogeneous surfaces. The citation merely indicates that different materials (e.g., titanium and nickel) may be used in the sputtering technique. For at least the foregoing reason, Applicants respectfully request withdrawal of the application of Roth as an anticipating reference.

### Summary

Applicants respectfully submit that the cited references do not teach every limitation of the presently pending claims. Accordingly, Applicants respectfully request allowance of the pending claims. Should the Examiner require any further information or wish to discuss any aspect of this Response, Applicants respectfully request that the Examiner contact the undersigned at the telephone number listed below.

With this response, Applicants respectfully petition for a three-month extension on the response deadline. The director is hereby authorized to deduct the extension fee and any other fee required for this response from deposit account 18-2000. This page is submitted in duplicate.

Respectfully submitted,

  
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January 15, 2004

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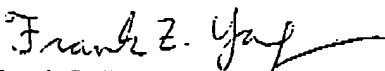
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#### Summary

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